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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			COLIN, CARL G	
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			2136	

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/609,303

Applicant(s)

LAPSTUN ET AL.

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) see att.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 7/14/2004, applicant amends claims 8, 11, 13, 27, 29, and 34, and adds claims 35-38. The following claims 1-38 are presented for examination.

1.1 In response to communications filed on 7/14/2004, the amendment to the specification has been considered and the rejection has been withdrawn. However, applicant is requested to amend the specification, if necessary, to update the status of the co-pending applications. With respect to the amended claims, the objection to the claims has been withdrawn as well as the 112 rejection.

2. Applicant's arguments, pages 13-15, filed on 7/14/2004, with respect to the rejection of claims 1-34 have been fully considered, but they are persuasive. Applicant argues that the independent claims required the use of a printed registration form containing information relating to user registration and including coded data indicative of the identity of the form ... and in Wolff there is no description of any type of registration procedure, only a limited number of examples of use of the interactive paper are described and none of these encompass registration. Examiner respectfully disagrees. The claim language is broad in describing any type of registration procedure it merely cites "provided a printed registration form containing information relating to user registration and including coded data indicative of the identity of the form". Although the details of the invention are presented using a single application, as Wolff

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mentioned, the extension to other applications will be readily understood by those practicing the art (column 3, lines 20-41). From the many applications disclosed are form processing: "filling out of a prescribed form"; signature verification: "improved reliability of signature recognition obtained by storing the signature related time course using spatial location and pressure to characterize the signature" (column 2, lines 44-67 and column 3, lines 20-41); these applications read on the claim language of "provided a printed registration form containing information relating to user registration" and Wolff also discloses a calendar book that contains information relating to user registration and "digitally coded information is printed on each page so that the pen-instrument can be used to read the pertinent digital code that identifies the page format (column 3, lines 25-41) that meets the recitation of a form including coded data indicative of the identity of the form. See also column 1, lines 40-46 and column 9, lines 9-12. Wolff discloses a pen-instrument for sensing writing forces, motion of the pen and written characters using coded data on the form and a base unit for receiving information generated from the pen-instrument and interpreting, storing, and displaying interpreted results to the user for acceptance or correction (column 10, lines 1-15 and column 9, lines 1-40). Wolff adds that this procedure can be applied to the applications mentioned above. Therefore, information relating to filling out of a prescribed form, signing a form, signature verification, and interactive fax (see column 2, lines 43-67) are all parameters relating to user registration wherein the registration data include identification and contact details associated with the user. Wolff clearly discloses the independent claims and claims 6-7 as claimed. Applicant also argues that Wolff does not disclose time varying position information is generated using at least some of the coded data. This is disclosed for example in column 9, lines 1-38 and lines 58-63. Therefore, Applicant has

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not overcome the rejection of the claims discussed above and Examiner maintains rejection.

Claims 35-38 have been added to include the limitations of "the indicating data includes time varying position information regarding movement of the sensing device relative to the form generated by the sensing device during operation thereof using sensed coded data." It is noted that the sensed coded data can still be interpreted as scanned coded data in Wolff. However, to further clarify the rejection, claims 35-38 are rejected under Wolff and Sekendur. Claims 11, 23, 29, and 34 are amended to further limit that the coded data are invisible. Therefore, these claims are rejected in view of Wright et al.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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3.1 Claims 1, 17, 31, 43, 54, 56, and the intervening claims are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 5, 16 of prior U.S. Patent No. 6,644,545. This is a double patenting rejection.

Claims 1, 13, 24, and 30 and the intervening claims are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 15, 28, and 39 of copending Application No. 10/291,821. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4.1 **Claims 1-34** are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,081,261 to **Wolff et al.**

4.2 **As per claims 1, 13, and 15, Wolff et al.** discloses a method and system for enabling registration of a user to use a computer system, the method including: providing a printed registration form containing information relating to user registration, the form including coded data indicative of an identity of the form and of at least one reference point of the form (see column 9, line 64 through column 10, line 9; column 3, lines 25-40; and column 4, lines 7-37 and lines 52-58); receiving, in a processing system associated with the computer system, indicating data from a sensing device regarding the identity of the form and a position of the sensing device relative to the form, the sensing device, when placed in an operative position relative to the form, generating the indicating data using at least some of the coded data on the form (see column 9, line 39 through column 10, line 34; and column 6, lines 59 et seq.); and identifying, in the processing system and from the indicating data, at least one parameter relating to user registration, and storing the at least one parameter so as to be accessible by said computer system (see column 6, lines 59 et seq. and see column 9, line 39 through column 10, line 38).

As per claims 2 and 14, Wolff et al. discloses the limitation of wherein said at least one parameter relating to the user registration is associated with at least one zone of the form, and wherein the method includes identifying, in the processing system and from the zone relative to which the sensing device is located, said at least one parameter (see column 4, lines 7-37 and column 3, lines 42-65; see also column 9, lines 1-38).

As per claim 3, Wolff et al. discloses the limitation of wherein the indicating data includes time varying position information regarding movement of the sensing device relative to the form which is generated by the sensing device during operation thereof using at least some of the coded data, and wherein the method includes identifying, in the processing system and from the movement information of the sensing device at least partially within said at least one zone, said at least one parameter (see column 4, lines 7-51).

As per claims 4 and 18, Wolff et al. discloses the limitation of in which the at least one parameter is a text parameter of the user registration, the method including identifying, in the processing system, that said movement information of the sensing device represents an action of entering handwritten text data by means of the sensing device and effecting, in the processing system, an operation associated with the text parameter (see column 4, lines 7-12 and lines 52-67 and column 8, lines 48-67)

As per claims 5 and 19, Wolff et al. discloses the limitation of including converting, in the processing system, the identified handwritten text data into computer text (see column 7, lines 6-14 and column 6, lines 31-45).

As per claim 6, Wolff et al. discloses the limitation of wherein the at least one text parameter comprises registration data identifying said user (see column 3, lines 25-50 and column 8, lines 59-67).

As per claim 7, Wolff et al. discloses the limitation of wherein the registration data includes identification and contact details associated with said user (see column 3, lines 25-50).

As per claim 8, Wolff et al. discloses the limitation in which the parameter is a user authorization parameter, the method including identifying, in the processing system, that the user has entered a handwritten signature by means of the sensing device and storing data identifying the handwritten signature so as to be accessible by the computer system (see column 8, lines 59-67 and column 7, lines 5-14).

As per claims 9 and 21, Wolff et al. discloses the limitation of which includes printing the registration form on demand (see column 6, lines 46-52).

As per claims 10, 22, 28, and 33, Wolff et al. discloses the limitation which includes printing the form on a surface-defining means and, at the same time that the form is printed, printing the coded data on the surface (see column 1, line 59 through column 2, line 2 and column 3, lines 34-53).

As per claims 12, 17, and 32, Wolff et al. discloses the limitation of wherein the sensing device contains an identification means which imparts a unique identity to the sensing device, the method including storing the identity of the sensing device in association with the at least one parameter relating to user registration (see column 10, lines 34-38).

As per claim 16, Wolff et al. discloses the limitation of wherein the sensing device includes a marking nib (see column 7, lines 5-14).

As per claims 20 and 26, Wolff et al. discloses the limitation of wherein the at least one parameter relating to user registration includes information selected from the group of: identification information for the user; address information for the user; telephone details for the user; and privacy preferences for the user (see column 3, lines 25-50).

As per claims 24 and 30, Wolff et al. discloses a method and system for user registration of a computer system, the method including the steps of: providing a printed document registration form including registration information and coded data thereon, the coded data including an indication of an identity of the form and at least one reference point on the form (see column 9, line 64 through column 10, line 9; column 3, lines 25-40; and column 4, lines 7-37 and lines 52-58); receiving in the computer system indicating data from a sensing device, the indicating data including information regarding an identity of the sensing device, the identity of the form and at least one action of the sensing device in relation to the form generated by the sensing device using at least some of the coded data (see column 9, line 39 through column 10, line 45; and column 6, lines 59 et seq.); deriving, from the indicating data regarding at least one action of the sensing device in relation to the form, an identity of a user to be registered (see column 10, lines 34-40); and storing, in the computer system, registration data for the user including the identity of the user associated with the identity of the sensing device (see

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column 6, lines 59 et seq.; column 9, line 39 through column 10, line 38 and column 10, lines 34-38).

As per claims 25 and 31, **Wolff et al.** discloses the limitation of wherein the at least one action of the sensing device in relation to the form includes the formation of handwritten text and/or markings on the form (see column 10, lines 34-40).

As per claim 27, **Wolff et al.** discloses the limitation of including receiving in the computer system authorizing data from a second sensing device, the authorizing data including information regarding the identity of the second sensing device, the identity of the form and at least one action of the second sensing device in relation to the form generated by the second sensing device using at least some of the coded data, the second sensing device being associated in the computer system with a second user authorized to permit user registrations (see column 10, lines 34-40). **Wolff et al.** discloses multiple users and sensing device associated with each user. The same invention disclosed can be applied to multiple users.

5. **Claims 35-38** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,081,261 to **Wolff et al.** in view of US Patent 5,477,012 to **Sekendur**.

As per claims 35-38, **Wolff et al** substantially discloses the claimed method and system of claims 1, 13, 24, and 30 but does not disclose the sensing device generating indicating data that includes time varying position information regarding movement of the sensing device

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relative to the form using sensed coded data. It is noted that the scanned coded data can be interpreted as sensed coded data because they have to be sensed by sensors or readers.

Sekendur in an analogous art teaches providing a surface paper with position-related coding means having a plurality of reference points or coordinates for designating coordinates relative to the paper, and discloses indicating data includes time varying position information regarding movement of the sensing device relative to the form generated by the sensing device during operation thereof using sensed coded data for example (see column 4, lines 10-60). The invention discloses many advantages such as a system that indicates precisely the movement and position of a movable element within a plane or a three dimensional element, for example (see columns 2-3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the pre-printed form of **Wolff** to provide a form with a plurality of reference points, the coded data identifying a unique location of each of the reference point relative to the form as taught by **Sekendur** and indicating data that includes time varying position information regarding movement of the sensing device relative to the form generated by the sensing device during operation thereof using sensed coded data in order to indicate precisely the movement and position of a pen within a plane or a three dimensional element, for example (see columns 2-3). This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Sekendur** so as to benefit from precisely generating, obtaining, and outputting the movement and position of a pen within a plane or any three dimensional element, for acquisition and outputting of hand written data, for example (see column 2, lines 20-35 and 45-61 and abstract).

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6. **Claims 11, 23, 29, and 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,081,261 to **Wolff et al** in view of US Patent 4,864,618 to **Wright et al**.

As per claims 11, 23, 29, and 34, Wolff et al substantially discloses the claimed method and system of claims 1, 13, 24, and 30. **Wolff et al** does not explicitly disclose printing the coded data to be invisible. However, **Wright et al** discloses the limitation of wherein the information relating to user registration and the coded data are printed simultaneously (column 13, lines 23-31) so that both visible and invisible information can be verified together and non-conformity can be distinguished thereby providing an additional level of security (column 13, lines 32-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a printed registration form wherein the registration and the coded data are printed simultaneously and the coded data are invisible so that both visible and invisible information can be verified together and non-conformity can be distinguished thereby providing an additional level of security as taught by **Wright et al**. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Wright et al** so as to allow both visible and invisible information to be verified together and non-conformity can be distinguished, thereby providing an additional level of security (column 13, lines 32-50).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706:07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7.1 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses the use of authentication between a client and/or user and one or more servers.

US Patents: 5,247,137 Epperson; 6,088,695 Kara; 5,661,506 Lazzouni et al.

7.2 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Carl Colin

Patent Examiner

June 30, 2005



AYAZ SHEIKH

SUPERVISORY PATENT EXAMINER
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